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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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R. Neil Sudol
714 Colorado Avenue
Bridgeport, CT 06605-1601

EXAMINER

FLANAGAN, BEVERLY MEINDL

| ART UNIT | PAPER NUMBER |
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3739

DATE MAILED: 02/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/668,542

Applicant(s)

PISKUN, GREGORY

Examiner

Beverly M. Flanagan

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) 1-16,38 and 39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31,33-37 and 40 is/are rejected.
- 7) ☒ Claim(s) 32 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.


BEVERLY M. FLANAGAN
PRIMARY EXAMINER

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Previously Set Forth Rejections

The 35 U.S.C. § 102(e) rejection of claims 17-25, 28-31, 33-35 and 40 as being anticipated by Bimbo et al. (U.S. Patent No. 6,551,270) is hereby *maintained*. The 35 U.S.C. § 103(a) rejection of claims 26 and 27 as being unpatentable over Bimbo et al. (U.S. Patent No. 6,551,270) in view of Bonadio (U.S. Patent No. 5,803,921) is hereby *maintained*. The 35 U.S.C. § 103(a) rejection of claims 36 and 37 as being unpatentable over Bimbo et al. (U.S. Patent No. 6,551,270) in view of Yoon (U.S. Patent No. 5,540,648) is hereby *maintained*.

The following reiterated grounds of rejection are set forth:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 17-25, 28-31, 33-35 and 40 are rejected under 35 U.S.C. 102(e) as being anticipated by Bimbo et al. (U.S. Patent No. 6,551,270).

In regard to claims 17, 28, 29 and 33, Bimbo et al. teach a port assembly 60 having an outer housing 62 with an enlarged upper section 64, a reduced diameter section 66 and an expanded lower section 68 (see Figures 8-12). An access opening 70 in middle section 66 has a pair of openings 72, 74 for passage of instruments and opening 70 is preferably formed of a resilient material (see col. 8, lines 1-15). Figures 8-12 show that access opening 70 constitutes a plate member with a surrounding edge, housing 62 constitutes a wall surrounding the access opening 70 that is connected to the opening 70 all along the surrounding edge where the housing 62 has a longitudinal axis and the access opening 70 extends substantially transversely to the longitudinal axis. **In regard to claims 18 and 19**, Figures 8-12 show that the access opening 70 and the housing 62 each have a height dimension extending parallel to the longitudinal axis and the height dimension of the housing 62 is greater than the height dimension of the access opening 70. **In regard to claims 20, 21 and 34**, Figure 11 shows that the housing 62 has two end portions (upper section 64 and lower section 68) that extend as endless flanges to the access opening 70. **In regard to claims 22 and 23**, Figure 11 shows that the access opening 70 is located at one end of the housing 62 (i.e., the inner end). **In regard to claim 24**, Figure 11 shows that the access opening 70 and the housing 62 form a cup shape. **In regard to claim 25**, Figure 11 shows that the housing 62 has a first inner diameter at the access opening 70 and a second inner diameter at an end opposite the access opening and the second inner diameter is larger than the first inner diameter. **In regard to claim 30**, Figure 11 shows that the access opening 70 is provided at the openings 72, 74, with extensions elongating the apertures. **In regard**

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to claim 31, Figure 11 shows that the access opening 70 has a first height dimension extending parallel to the longitudinal axis and the extensions have a second height dimension extending parallel to the longitudinal axis and the first height dimension is at least as great as the second height dimension. **In regard to claim 35**, one of the openings 72, 74 could be used as a gas channel for the introduction of an insufflation gas into a patient.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bimbo et al. (U.S. Patent No. 6,551,270) in view of Bonadio (U.S. Patent No. 5,803,921).

In regard to claims 26 and 27, Bimbo et al. are silent as to the access opening 70 or housing 62 being inflatable. However, Bonadio discloses an inflatable access port device 40 for introducing surgical instruments (see Figures 10-27 and col. 7, lines 55-65). Bonadio thus demonstrates that inflatable access port devices for surgical instruments are well known in the art. Since Bimbo et al. disclose that the access opening 70 and housing 62 are resilient, it would have been obvious for one of ordinary

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skill in the art at the time the invention was made to make the opening 70 and housing 62 inflatable, as a means to further anchor the device in the incision.

Claims 36 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bimbo et al. (U.S. Patent No. 6,551,270) in view of Yoon (U.S. Patent No. 5,540,648).

In regard to claims 36 and 37, Bimbo et al. are silent as to an anchoring element for the device. However, Yoon discloses a similar medical instrument introduction device having an anchoring system, 24 comprised of anchoring needles 26 that can be retracted (see col. 4, lines 55-65). Yoon thus demonstrates that anchoring devices for medical instrument introducers are well known in the art. Accordingly, it would have been obvious for one of ordinary skill in the art at the time the invention was made to provide the device of Bimbo et al. with the anchoring system 24 disclosed by Yoon.

Allowable Subject Matter

Claim 32 remains objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant argues that the instant invention is “basically” disclosed in his prior patent U.S. Patent No. 6,454,783, that the patent was filed September 15, 1999, well in advance of the August 30, 2000 filing date of the Bimbo reference, and that the patent is not prior art to the claims of the instant invention since the instant application was filed prior to the one year anniversary of the patent and has common inventorship with the patent. However, applicant has not claimed priority to the application of the prior patent under 35 U.S.C. § 120 and therefore cannot rely upon the disclosure in the patent as a means to exclude prior art. Since there is no chain of continuity properly established between the patent and the instant application, the instant application is only entitled to its filing date (September 23, 2003). In other words, the instant application cannot claim priority to the filing date of the patent based upon disclosure that is “basically” set forth in the patent since the conditions and requirements of 35 U.S.C. § 120 have not been met. Furthermore, while applicant is correct that the patent is not prior art under 35 U.S.C. §§ 102 and 103 (because of the common inventorship), it is prior art under 35 U.S.C. § 101 for the purposes of double patenting, which has been considered by the examiner. Applicant is incorrect in stating that since the instant application was filed prior to the one year anniversary of the patent, the patent is not prior art. The one-year time bar established by 35 U.S.C. § 102 is irrelevant where there is common inventorship.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Beverly M. Flanagan whose telephone number is (571) 272-4766. The examiner can normally be reached on Mondays, Tuesdays and Thursdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Beverly M. Flanagan
Primary Examiner
Art Unit 3739
